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Docket No.: 20140-00262-US1
(PATENT)

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Dated: 1.3.2005

Signature:

Joy D. Pickett

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Chen et al.

Application No.: 10/782,922

Confirmation No.: 7529

Filed: February 23, 2004

Art Unit: 3723

For: POLISHING PADS WITH POLYMER FILLED
FIBROUS WEB, AND METHODS FOR
FABRICATING AND USING THE SAME

Examiner: Nguyen, D. V.

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed December 1, 2004, applicant hereby provisionally elects Group I, claims 14-18 for continued examination, with traverse.

The outstanding Office Action has required restriction between:

Group I, claims 14-18, drawn to a method of making a polishing pad, classified in class 264, subclass 319; and

Group II, claims 18-24, drawn to a method of polishing a surface, classified in class 451, subclass 41.¹

¹ Outstanding Office Action dated December 1, 2004, page 2, lines 1-10.

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Applicants make these elections based on the understanding that Applicants are not prejudiced against filing one or more divisional applications that cover the non-elected claims.

Applicants respectfully traverse the Restriction Requirement for the following reasons.

MPEP Section 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

In particular, the claims of the present invention would appear to be part of the same technology area (i.e., method/apparatus for polishing). Though the Commissioner may require restriction if two or more independent and distinct inventions are claimed in a single application (37 CFR 1.142(a)), in the present case, the claimed subject matter may be classified in different subclasses of the same class and Applicants respectfully submit the inventions are not independent. That is, Applicants respectfully submit that an examination of one set of claims will require a search in the classes common to the same technology area, particularly since Group I and Group II both include claim 18.

Therefore, Applicants respectfully request that the Restriction Requirement be withdrawn. However, if the present Restriction Requirement is not withdrawn, examination on the merits of claims 14-18 is believed in order and an early and favorable action to that effect is respectfully requested.

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Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 22-0185, from which the undersigned is authorized to draw.

Dated: January 3, 2005.
37436_1

Respectfully submitted,

By Myron K. Wyche
Myron K. Wyche, Reg. No. 47,341
CONNOLLY BOVE LODGE & HUTZ LLP
1990 M Street, N.W., Suite 800
Washington, DC 20036-3425
(202) 331-7111
(202) 293-6229 (Fax)
Attorney for Applicant